

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 12

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENJI KUROKI, YOSHINAO HARADA and SHUNICHROH OTA

Appeal No. 98-1529
Application No. 08/446,375¹

ON BRIEF

Before ABRAMS, PATE, and McQUADE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application for patent filed May 22, 1995. According to appellants, this application is a division of Application 08/051,507 filed April 22, 1993, now abandoned.

This is an appeal from the decision of the examiner finally rejecting claims 6-11 and 17,² which constitute all of the claims remaining of record in the application.

The appellants' invention is directed to a method for manufacturing an enclosed hard disk drive. The claims on appeal have been reproduced in an appendix to the Brief.

THE REFERENCES

The references relied upon by the examiner to support the final rejection are:

Takahashi et al. (Takahashi)	5,108,812	Apr.
28, 1992		

Japanese Patent Publication	64-4996	Jan. 10, 1989
(Yamaguchi)		

THE REJECTIONS

Claim 17 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

² An amendment to claim 6 was after the final rejection was entered by the examiner, but it failed to overcome any of the rejections.

Claims 6-11 and 17 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention.

Claims 6, 8 and 11 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Yamaguchi.

Claims 7, 9, 10 and 17 stand rejected under 35 U.S.C. § 103 as being unpatentable over Yamaguchi in view of Takahashi.

The rejections are explained in the Examiner's Answer.

The viewpoints of the appellants are set forth in the Brief.

OPINION

The Rejection Under 35 U.S.C. § 112, First Paragraph

Claim 17 adds to claim 6 the requirement that the treating step "further coats said surface with a porous layer." In the examiner's view, this is "inconsistent with a disclosed embodiment as illustrated in Fig.1" where, in the examiner's opinion, "the treated surface (top surface) is not coated with a porous layer." The examiner has apparently misunderstood the description of the preferred embodiment of the invention. We agree with the appellants that the disputed feature is disclosed on page 7 of the specification. From our

perspective, one of ordinary skill in the art would have understood from the specification that the treatment of the component of the enclosed hard disk drive could include coating the component of the hard disk enclosure with a porous layer, whereupon the micro holes would originate in the coating. Thus, we cannot agree with the examiner that the appellants' were not in possession of this feature of the invention when the application was filed.

This rejection is not sustained.

The Rejection Under 35 U.S.C. § 112, Second Paragraph

The examiner finds two problems with the language of claim 6. The first is that the phrase "treating a surface" is unclear. He has not, however, provided reasons why this is the case, and we can find none. Second, the examiner contends that whereas the claim recites that forming the micro holes increases the size of the treated surface, it actually is decreased. It is clear to us, however, that such is not the case. Considered in the light of the specification, it is clear that "area size" and "surface" should be interpreted as applying to the total exposed area, including both the planar surface and the inner surfaces of the micro holes.

This rejection is not sustained.

The Rejection Under 35 U.S.C. § 102(b)

Anticipation is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of the claimed invention. See *In re Paulsen*, 30 F.3d 1475, 1480-1481, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994). Claim 6 contains the step of "treating a surface" of one or more components "by forming micro holes . . . [which] penetrate less than the thickness of the components." From our perspective, Yamaguchi has two shortcomings as an anticipatory reference. First, there is no teaching in Yamaguchi of treating a surface in order to produce the required micro holes. The reference simply states that a "capillary condensation means having multiple hollows or capillary tubes" that may be "of a porous material" is installed in the wall of the disk enclosure (translation, pages 3 and 4). The reference does not describe how this element is formed, and does not teach "treating a surface" at all, much less treating it to form micro holes. The second deficiency is that even if the capillaries of Yamaguchi are considered to be

micro holes, they extend completely through the component, rather than extending less than the thickness thereof, as required by claim 6. We are not persuaded otherwise by the examiner's arguments, which in our view take the language of Yamaguchi's claim 1 out of context.

This rejection of independent claim 6 and dependent claims 8 and 11 is not sustained.

The Rejection Under 35 U.S.C. § 103

This rejection encompasses dependent claims 7, 9, 10 and 17, which add to claim 6 the manner in which the micro holes are formed and, in the case of claim 17, that the treating step includes coating the surface with a porous layer. Even considering Yamaguchi in the light of 35 U.S.C. § 103,³ it is our opinion that the deficiencies pointed out above in the discussion of the Section 102 rejection still are present. The added teachings found in Takahashi, which was cited by the examiner for its teachings of specific ways in which to form micro holes, fail to alleviate the basic problems of the

³ The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

primary reference with regard to claim 6, from which the other claims depend. All in all, the combined teachings of the two references fail to establish a *prima facie* case of obviousness with regard to the subject matter recited in claims 7, 9, 10 and 17, and we will not sustain this rejection.

SUMMARY

None of the rejections are sustained.

The decision of the examiner is reversed.

REVERSED

NEAL E. ABRAMS)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
WILLIAM F. PATE)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN P. McQUADE)	
Administrative Patent Judge)	

NEA/jlb

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